

Remarks

Reconsideration is respectfully requested. Claims 1-10 and 16-28 are in the case. Claims 1-10, 18 and 22 have been withdrawn. Claims 11-15, and 21 have been cancelled. Claims 23-28 are new. Claims 16-17, and 19-20 stand rejected.

Claim Amendments

The applicant has amended claims 16 and 17 to provide some clarification.

Claim Rejections – 35 USC § 103

The examiner states the declaration filed on 5/30/2006 under 37 CFR 1.131 is ineffective to overcome the Scheibenreif reference for being insufficient to establish a reduction to practice the invention in this country or a NAFTA or WTO member country. Applicant submits herewith a new declaration executed by the first named inventor which clearly establishes the reduction of practice of the invention as being in this country.

The examiner has rejected claims 16, 17 and 19-21 under 35 U.S.C. 103(a) as being unpatentable over Scheibenreif et al (US 2005/0036746). Applicant respectfully requests reconsideration of this rejection for the following reasons:

Scheibenreif et al. has an earliest effective date of July 23, 2003. However, the invention date of the subject matter of claims 16, 17 and 19-21 precede that date as evidenced by the attached declaration under 37 C.F.R. § 1.131, along with photocopies of the supporting documents that are provided herewith. In particular, the declaration along with the photocopies of the supporting documents show that the subject matter of claims 16, 17 and 19-21 has a conception date at least as early as June 14, 2002, and subsequent diligence beginning at least prior to the earliest effective date of Scheibenreif et al. (July 23, 2003) until filing of the subject patent application on December 30, 2003. Therefore, the invention date of the subject matter of claims 16, 17 and 19-21 predates the effective date of Scheibenreif et al., rendering Scheibenreif an ineligible reference. Applicant, therefore, respectfully requests the examiner reconsider the rejection under section 102(b) and allow claims 16, 17 and 19-21.

Claim Rejections – 35 USC § 103

The examiner has rejected claims 16, 17 and 19-20 under 35 U.S.C. 103(a) as being unpatentable over Yamaji et al. US 5,708,745 (hereinafter Yamaji) in view of Montalvo et al. US 2003/0147385 A1 (hereinafter Montalvo). Applicant respectfully traverses. Reconsideration is respectfully requested.

Respectfully, to reject the claims in an application under Section 103 the Examiner's analysis must comply with the obviousness analysis required by Section 103 as interpreted by the Court. It is well settled that in obviousness rejections, the Examiner is to:

- 1) view the invention as a whole,
- 2) identify the difference with the prior art,
- 3) identify those of ordinary skill in the art, and
- 4) determine whether those of ordinary skill in the art will be motivated to make the modification to the prior art to arrive at the claimed invention.

Applicant's claim 16 currently reads as follows:

16. An optical communications system, comprising:
a client computing device including a microprocessor and a network processor coupled to one another; and
a XENPAK- sized optical communications adapter module housing coupled to the client computing device, an optical communications board assembly of a type other than a XENPAK board assembly being positioned within the module housing so the optical communications board assembly is capable of coupling with the client computing device through an electrical connector, a first optical connector coupled with the optical communications board assembly for data transmission, a second optical connector positioned in connector openings of the module housing, a first optical conversion cord adapted to couple the first optical connector to the second optical connector. (underlining added)

Yamaji's teaching is directed to preventing laser beam leakage from a laser source, and has very little in common with applicant's invention when viewed as a whole which includes positioning a board assembly of a type other than the

XENPAK board assembly in a XENPAK-sized module. Yamaji's optical transmission apparatus 1 (FIG. 4) is clearly not in a XENPAK sized module housing.

Yamaji teaches "A DEVICE FOR PREVENTING LASER BEAM LEAKAGE" (title) comprising shields (2b, 2c) FIGS 1, 2, 5 & 6 that close when a connector (7) is removed from the outside of a connector opening 2 of an optical transmission apparatus 1. A printed circuit board 13 (FIG. 4) is disposed within the optical transmission apparatus 1. A "laser beam supply means (12) [on the printed circuit board 13 is] to supply the laser beam to the internal connector" (column 4 lines 36-37).

Claim 16 has been amended and now includes the limitations of claim 21 which is now cancelled. Regarding claim 21, the Examiner states:

"Montalvo et al teach that the ports of the system can include industry-standard modules such as XENPAK-sized modules (see paragraph 24)."

Respectfully, the reference does not teach, nor suggest, using XENPAK-sized modules, but instead teaches using existing switching hardware as is - i.e. using, an actual XENPAK module, as an example piece of hardware - as is. Montalvo makes no suggestion to use "a XENPAK-sized optical communications module housing ... [and] an optical communications board assembly of a type other than a Xenpak board assembly being positioned within the module housing..." as claimed by applicant.

Montalvo discloses "a switching device for dividing a relatively high speed data stream into a plurality of relatively low speed data streams" (paragraph [0002]). The switching device includes a "physical port, 112 [which] provides an interface to the transport medium 102, which is a fiber optic cable in the preferred embodiment."

Montalvo simply suggests using an off-the-shelf industry standard fiber optic module, without modification. In fact, he teaches away from modifying any industry standard fiber optic module. Montalvo states at the end of paragraph [0003]:

"[T]here is thus a need to capitalize on the variety of existing switching hardware operable at gigabits speeds, which is readily available and whose reliability is proven."

Regarding the section from Montalvo quoted by the Examiner in paragraph 14 of the action, i.e.

“One skilled in the art will recognize, because of the variety of physical and optical fiber optic connection types, that the physical port 112 may be partially or completely contained in an industry-standard fiber optic module such as XENPAK, XPAK, XFP, MSA 300, or MSA 200.”

Montalvo illustrates his invention schematically with block diagrams. The port 112 is illustrated in FIG. 1. The language “partially or completely contained in an industry-standard fiber optic module such as XENPAK, XPAK, XFP, MSA 300, or MSA 200” merely illustrates possible locations of a physical port from among the industry-standard fiber optic modules listed. Montalvo does not suggest positioning an optical communications board assembly of a type other than a XENPAK board assembly within an XENPAK module housing. Again Montalvo specifically teaches “capitaliz[ing] on the variety of existing switching hardware operable at gigabits speeds, which is readily available and whose reliability is proven.” To put anything other than a XENPAK board assembly into a XENPAK module housing is to attempt something that is not proven. Only the applicants teach, and claim doing so, and teach the advantages of doing so. The references cited do not.

Using Yamaji and Mantalvo and any other material that may be readily available one of ordinary skill the art would not motivate one to modify Yamaji or Mantalvo, and to arrive at applicants’ invention as claimed in claim 16. Therefore claim 16 is not obvious. Reconsideration and allowance of the claim is respectfully requested.

Claims 17 and 19-21 depend from and include all the limitations of base claim 16 which is in condition for allowance, as discussed. By virtue of being dependent on an allowable claim claims 17 and 19-21 should also be allowed. Reconsideration and allowance is respectfully requested.

New claims

Applicant submits herewith new claims 23-27 for consideration. The claims are believed to be in condition for allowance. Allowance is respectfully requested.

Double Patenting Rejection

The examiner has provisionally rejected claims 16, 20 and 21 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-20 of copending Application No. 10/748982. The copending application No. 10/748982 has issued as US Patent 7,008,122.

Applicant agrees herewith to submit a terminal disclaimer, in accordance with 37 CFR 3.73(b), when the claims are otherwise allowable and the double patenting rejection is no longer provisional.

Conclusion

Applicant submits claims 16, 17 and 19-27 are in condition for allowance. A Notice of Allowance is respectfully requested.

If there are any questions, the Examiner is invited to contact the undersigned at (503) 796-2496. Also, the Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

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